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PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Ken R. POWELL, Kevin W. Hartley,) Art Unit: 2165
Eleanor B. MAXWELL, and Corey C. SNOOK)
Serial No.: 09/301,749) Examiner: C. Nguyen
Filed : April 29, 1999)
For: COMPUTER SYSTEM CONFIGURATION)
AND METHOD FOR A STORE)



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Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

APPELLANT'S BRIEF UNDER 37 C.F.R. § 1.192

1. PROCEDURAL HISTORY

Appellant filed this Application April 29, 1999 with claims 1-46, and filed a Preliminary Amendment on June 7, 1999 resulting in claims 19-24, 26, 28-40, and 42-46.

In an Office Action mailed April 24, 2001, the Examiner rejected the pending claims under, *inter alia*, 35 U.S.C. § 112, second paragraph, "as failing to set forth the subject matter which applicants regard as their invention." (Office Action mailed April 24, 2001, pages 5-6).

Appellant filed a Response including an Amendment and Remarks on July 5, 2001.

In a Final Office Action mailed September 25, 2001, the Examiner again rejects the pending claims under 35 U.S.C. § 112, second paragraph, "as failing to set forth the subject matter which applicants regard as their invention."

The Examiner sets forth various rationale for rejecting each of independent claims 29, 43, 35, and 19. (Final Office Action pages 7-8). The Examiner states that claims 20-24, 26, 28, 30-34, 36-40, 42, 44-46 are rejected under 35 U.S.C. §112, second paragraph, because they are dependent on their parent claims. (Final Office Action page 8).¹

Pursuant to 37 C.F.R. § § 1.191-1.198, Appellant now submits this Brief in support of an Appeal to the Board of Patent Appeals and Interferences of the rejections in the Final Office Action. Enclosed is a Credit Card Payment Form bearing a \$320 payment amount for filing this Brief.

Attached to this Brief is an appendix, entitled "Pending claims," containing a copy of claims 19-24, 26, 28-40, and 42-46 in their form existing after the Final Office Action.

2. REAL PARTY IN INTEREST

The real party in interest is SoftCard Systems Inc.

1. Incidentally, on pages 4-6 and 10-14 of the Final Office Action, the Examiner cites various cases governing the interpretation of 35 U.S.C. § 103, and on pages 9-10 the Examiner briefly discusses some references and cites claims 43, 19, 29, and 35. In the Final Office Action, however, the Examiner does not formally reject any claim under § 103. During a telephonic discussion between the Examiner and Appellant's representative on November 8, 2001, the Examiner confirmed that the Final Office Action was not intended to reject any claim under § 103.

3. RELATED APPEALS AND INTERFERENCES

The instant Application is a parent application of two other applications for which appeals have been filed:

Appellant's Application Serial No. 09/317,440 Filed May 24, 1999 for REGISTER SYSTEM CONFIGURATIONS AND METHODS FOR A STORE, Notice of Appeal filed December 7, 2001, Appeal Brief filed January 8, 2002; and

Appellant's Application Serial No. 09/320,664 Filed May 27, 1999 for COMPUTER SYSTEM WITH PROGRAM CONFIGURATIONS AND METHODS FOR A STORE, Notice of Appeal filed December 7, 2001, Appeal Brief filed January 8, 2002.

Appellant does not believe that these two other applications will affect or be affected by or have a bearing on the Board's decision in the instant appeal. Appellant nevertheless brings these two other applications to the attention of the Board.

4. STATUS OF CLAIMS

Claims 19-24, 26, 28-40, and 42-46 are pending, and claims 1-18, 25, 27, and 41 are canceled. Claims 19-24, 26, 28-40, and 42-46 are the subject of this appeal.

5. STATUS OF AMENDMENTS

No amendments were filed after the final rejection.

6. BACKGROUND AND SUPPORT IN THE SPECIFICATION
AND SUMMARY OF THE INVENTION

Following is a summary of the invention and of specification support, not limitation, of the claims defining the invention.

Figs. 1 and 2 show store 1 including computer network 7 and computer network 9. Some computers in checkout stations 300, 301, 302 communicate with financial computer 40 in network 7. Other computers in checkout stations 300, 301, 302 communicate with computer 42 in network 8. (Specification page 7, line 12 page 8, line 1).

Figs. 6A and 6B emphasize other aspects of store 1. Checkout station 300 includes card interface system 320 having a card interface slot 314. Checkout station 301 includes card interface system 321 having a card interface slot 314. Checkout station 302 includes card interface system 322 having a card interface slot 314. (Specification page 12, lines 2-5). Fig. 14 emphasizes other aspects of store 1.

Fig. 15 is a block diagram of checkout station 300 including cash register system 330 and card interface system 320. CPU 350 in system 330 communicates with CPU 352 in system 320 via RS232 line 328, as discussed in more detail below. In card interface system 320, CPU 352 executes program 342 in memory 333. CPU 352 and program 342 act to receive electronic coupons from a customer card, via reader/writer 315. CPU 352 determines if a product has a corresponding electronic coupon offer. (Specification page 21, lines 15-20).

Appellant's invention is defined in the claims.

Independent Claim 19

As recited in independent claim 19, there is a system for operating with a plurality of portable cards each having a card memory, and a store having a plurality of products. The system of claim 19 includes a plurality of cash register stations. Each cash register station includes an electromagnetic detector for generating first signals corresponding to product pricing and for generating second signals identifying products selected for purchase. Support for the “electromagnetic detector” includes, for example, bar code reader 310 shown in Figs. 6A and 15. Support for “generating first signals corresponding to product pricing” includes, for example, page 15, line 7-8, stating that a checkout clerk scans paper coupons past bar code reader 310. Support for “generating second signals identifying products selected for purchase” includes, for example, page 15, line 6, stating that the checkout clerk scans selected products past bar code reader 310.

Each cash register station includes a card interface for reading third signals corresponding to product pricing from the card memory of one of the portable cards. Support for the “card interface” includes, for example, reader 315 having slot 314 shown in Figs. 6A and 15. Support for “reading third signals corresponding to product pricing from the card memory of one of the portable cards” includes, for example, page 21, line 17-18, stating that system 320 acts to receive electronic coupons from a customer card, via reader/writer 315.

Each cash register station includes a first processing unit that executes a first program in a first memory to correlate second signals with first signals. Support for this “first processing

unit” includes, for example, page 15, lines 10-11, stating that a CPU and program in system 330 processes the paper coupon information in the context of the selected products to determine discount eligibility.

The system of claim 19 also includes a plurality of second processing units, each second processing unit executing a second program in a second memory, to correlate second signals from the electromagnetic detector, in a respective one of the cash register stations, with the third signals read by the card interface, in the respective one of the cash register stations. Support for this “second processing unit” includes, for example, page 15, lines 15-17, stating that a CPU and program in system 320 perform electronic coupon redemption, by processing the selected products in the context of the coupon information from the customer’s card to determine discount eligibility.

Independent Claim 29

As recited in independent claim 29, there is a system for operating with a plurality of portable cards each having a card memory, and a store having a plurality of products. The system of claim 29 includes a plurality of cash register stations. Each cash register station includes an electromagnetic detector for generating first signals corresponding to product pricing and for generating second signals identifying products selected for purchase. Support for the “electromagnetic detector” includes, for example, bar code reader 310 shown in Figs. 6A and 27. Support for “generating first signals corresponding to product pricing” includes, for example,

page 15, line 7-8, stating that a checkout clerk scans paper coupons past bar code reader 310. Support for “generating second signals identifying products selected for purchase” includes, for example, page 15, line 6, stating that the checkout clerk scans selected products past bar code reader 310.

Each cash register station includes a card interface for reading third signals corresponding to product pricing from the card memory of one of the portable cards. Support for the “card interface” includes, for example, reader 315 having slot 314 shown in Figs. 6A and 27. Support for “reading from the card memory of one of the portable cards” includes, for example, page 31, line 14-15, stating that system 320’ acts to receive electronic coupons from a customer card, via reader/writer 315.

Each cash register station includes a first processing unit that executes a first program in a first memory to correlate second signals with first signals. Support for this “first processing unit” includes, for example, page 15, lines 10-11, stating that a CPU and program in system 330 processes the paper coupon information in the context of the selected products to determine discount eligibility.

Each register station of claim 29 includes a signal path between a peripheral device and the first processing unit. Support for this “signal path” includes, for example, interface bus 351 shown in Fig. 27.

Each cash register station of claim 29 also includes second processing unit that executes a second program in a second memory, to correlate second signals with the third signals.

Support for this “second processing unit” includes, for example, page 35, lines 6-9, stating that CPU 352 detects correspondence between UPC product codes and coupons on a card.

Claim 29 also recites that “the first processing units determines a total amount due by receiving a fourth signal from the second processing unit.” Support for this feature of claim 29 includes, for example, page 35, lines 14-17, stating that CPU 350 receives a discount tender from CPU 352 and calculates a total amount due.

Independent Claim 35

As recited in independent claim 35, there is a method for a system including a plurality of portable cards each having a card memory, a store having a plurality of products, and a plurality of cash register stations. This method recites generating first signals corresponding to product pricing and generating second signals identifying products selected for purchase.

Support for “generating first signals corresponding to product pricing” includes, for example, page 15, line 7-8, stating that a checkout clerk scans paper coupons past bar code reader 310. Support for “generating second signals identifying products selected for purchase” includes, for example, page 15, line 6, stating that the checkout clerk scans selected products past bar code reader 310.

Support for “reading third signals corresponding to product pricing from the card memory of one of the portable cards” includes, for example, page 21, line 17-18, stating that system 320 acts to receive electronic coupons from a customer card, via reader/writer 315.

Support for executing a first program in a first memory to correlate second signals with first signals includes, for example, page 15, lines 10-11, stating that a CPU and program in system 330 processes the paper coupon information in the context of the selected products to determine discount eligibility.

Support for executing a second program in a second memory includes, for example, page 15, lines 15-17, stating that a CPU and program in system 320 perform electronic coupon redemption, by processing the selected products in the context of the coupon information from the customer’s card to determine discount eligibility.

Independent Claim 43

As recited in independent claim 43, there is a method for a system including a plurality of portable cards each having a card memory, and a store with a plurality of products. Support for “generating first signals corresponding to product pricing” includes, for example, page 15, line 7-8, stating that a checkout clerk scans paper coupons past bar code reader 310. Support for “generating second signals identifying products selected for purchase” includes, for example, page 15, line 6, stating that the checkout clerk scans selected products past bar code reader 310.

Support for “generating third signals by reading from the card memory of one of the portable cards” includes, for example, page 31, line 14-15, stating that system 320’ acts to receive electronic coupons from a customer card, via reader/writer 315.

Support for “executing a first program in a first memory to correlate second signals with first signals,” includes, for example, page 15, lines 10-11, stating that a CPU and program in system 330 processes the paper coupon information in the context of the selected products to determine discount eligibility.

Support for “executing, responsive to the device signal “includes, for example, page 34, line 20-page 35, line 1, stating that CPU 352 in system 320’ monitors bus 351 to detect UPC product codes from barcode reader 310.

6. ISSUE

The issue is whether claims 19-24, 26, 28-40, and 42-46 are unpatentable under 35 U.S.C. § 112, second paragraph, “as failing to set forth the subject matter which applicants regard as their invention.”

7. GROUPING OF CLAIMS

With respect to the Examiner’s rejection under 35 U.S.C. § 112, second paragraph, claims 19-24, 26, and 28 (Group A) do not stand or fall together with claims 29-34 (Group B) or with claims 35-40, and 42 (Group C), or with claims 43-46 (Group D). With respect to the

Examiner's rejection under 35 U.S.C. § 112, second paragraph, Group B does not stand or fall together with Group A, or with Group C, or with Group D.

With respect to the Examiner's rejection under 35 U.S.C. § 112, second paragraph, Group C does not stand or fall together with Group A, or With Group B, or with Group D.

With respect to the Examiner's rejection under 35 U.S.C. § 112, second paragraph, Group D does not stand or fall together with Group A, or With Group B, or with Group C.

8. ARGUMENT

These respective groups of claims do not stand or fall together under 35 U.S.C. § 112 because, *inter alia*, the Examiner applied different, although overlapping, sets of rationale to reject the independent claims representing the respective groups. Furthermore, each representative independent claims recites language different from that of the other claims.

Claims 29-34 (Group B)
are Patentable under 35 U.S.C. § 112, Second Paragraph

In this Brief, claim 29 represents claims 29-34 (Group B).

“The test for whether a claim meets the definiteness requirement [of 112, para 2] is ‘whether one skilled in the art would understand the bounds of the claim’” *Process Control Corporation v. Hydrex Corporation*, 190 F.3d 1350, 1358 (Fed. Cir. 1999) (quoting *Personalized Media*, 161 F.3d 696, 705 (Fed. Cir. 1998)). Each of claims 29-34 employs common terminology to recite its features, and each feature is interrelated in a definite way with

every other feature. Thus, each of claims 29-34 points out and distinctly claims the subject matter that applicants regards as the invention.

The Examiner states:

Evidence that [claim 29 fails] to correspond in scope with that which applicant(s) regard as the invention can be found in Paper No. 1 filed 4/29/1999. In that paper, applicant has stated that the invention is about “a computer system configuration and method for processing discount information in a retail store.”, and this statement indicates that the invention is different from what is defined in the claim(s) because there is no such subject matter’s limitations in the bodies of those claims (a limitation of the claim only counts if it is disclosed in the body of a claim) These claims would be incomplete if this baseline is left-out; therefore, they are still proper with 35 U.S.C. § 112, second paragraph, rejections.

(Final Office Action page 7) (emphasis in original).

This rationale for the rejection of claim 29 is wrong because Applicants’ statement on page 1 of the specification, is that the “invention relates generally to a store and, more particularly to a computer system configuration and method for processing discount information in a retail store.” (Specification filed April 29, 1999, page 1, lines 4-5). First, to say that an invention “relates” to something is not the same as saying the invention is limited to something, and this rationale for the rejection of claim 29 is wrong for this reason alone.

Second, the “content of applicant's specification is not used as evidence that the scope of the claims is inconsistent with the subject matter which applicants regard as their invention . . . agreement, or lack thereof, between the claims and the specification is properly considered only

with respect to 35 U.S.C. 112, first paragraph; it is irrelevant to compliance with the second paragraph of that section.” Manual of Patent Examining Procedure (MPEP) 2172, II.

The Examiner states:

A limitation of claim 29 said “to correlate the second signals with third signals from the card memory . . .” the examiner submits that such card memory is a passive device, it does not have an “active” signal (as called “third signal”); therefore, the claim is not clear in this sense. The term for “third signal” is not correctly used herein.

(Final Office Action page 7) (emphasis in original).

This rationale for the rejection of claim 29 is also wrong. These terms employed by the Examiner, “passive device” and “active” signal, do not appear in the claims. In any event, the term “signal” is a broad one, encompassing a function, or an embodiment of a message. In other words, a memory may indeed have a signal.

The Examiner states:

[Claim 29 is] rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (the use of a computer system in this application). These claims would be incomplete if missing this element and they are rejected on 35 U.S.C. § 112, second paragraph. Viewing as a whole, those independent claims must include a computer system (or a computer-implemented method) for operating claimed means/steps (see at least the specification for using of a computer system in this

application); without claiming this structure as essential “baseline” of this application, the claim is incomplete.

(Final Office Action page 8).

This rationale for the rejection of claim 29 is wrong. The “content of applicant's specification is not used as evidence that the scope of the claims is inconsistent with the subject matter which applicants regard as their invention . . . agreement, or lack thereof, between the claims and the specification is properly considered only with respect to 35 U.S.C. 112, first paragraph; it is irrelevant to compliance with the second paragraph of that section.” Manual of Patent Examining Procedure (MPEP) 2172, II. “Section 112 ¶2 instructs the applicant to ‘distinctly claim[] the subject matter which the applicant regards as his invention.’ This does not automatically require inclusion in every claim of every element that is part of the device or its operation.” *Reiffin v. Microsoft Corp.*, 214 F.3d 1342, 1347 (Fed. Cir. 2000) (Newman concurring).

The Examiner also states

[T]he use of at least a computer is obviously required for this invention, without claiming it, the claim is incomplete and it can be rejected on 35 U.S.C. 112, second paragraph.

(Final Office Action page 3).

This statement by the Examiner is incoherent, since the claims themselves define the invention. Although an element of a claim may be supported by a structure in the specification, nothing in 35 U.S.C. § 112 requires that the claim be limited to that structure, or that the claim

recite particular terminology. Although a “first processing unit” recited in claim 29 may be supported by a CPU, for example, nothing in § 112 requires that claim 29 be limited to a CPU, or that claim 29 recite a “CPU,” “computer,” or any other particular terminology.

Claims 43-46 (Group D)
are Patentable under 35 U.S.C. § 112, Second Paragraph

In this Brief, claim 43 represents claims 43-46 (Group D).

Each of claims 43-46 employs common terminology to recite its features, and each feature is interrelated in a definite way with every other feature. Thus, each of claims 43-46 points out and distinctly claims the subject matter that applicants regards as the invention.

The Examiner states:

Claim 43 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This claim recites limitations of “. . . executing a second program . . . to correlate second signals with third signals . . .” there are insufficient antecedent basis for this limitation in claim (because said “third signal” is undefined, and therefore, indefinite).

(Final Office Action pages 7-8) (emphasis in original).

This rationale for the rejection of claim 43 is wrong. The term “signal” is *ipso facto* defined, having a common meaning. Furthermore, although nothing in 35 U.S.C. § 112 requires that the term “third signal” be limited, claim 43 does recite “generating third signals by reading from the card memory.”

The Examiner states:

Evidence that [claim 43 fails] to correspond in scope with that which applicant(s) regard as the invention can be found in Paper No. 1 filed 4/29/1999. In that paper, applicant has stated that the invention is about “a computer system configuration and method for processing discount information in a retail store.”, and this statement indicates that the invention is different from what is defined in the claim(s) because there is no such subject matter’s limitations in the bodies of those claims (a limitation of the claim only counts if it is disclosed in the body of a claim) These claims would be incomplete if this baseline is left-out; therefore, they are still proper with 35 U.S.C. § 112, second paragraph, rejections.

(Final Office Action page 7) (emphasis in original).²

This rationale for the rejection of claim 43 is wrong because Applicants’ statement on page 1 of the specification, is that the “invention relates generally to a store and, more particularly to a computer system configuration and method for processing discount information in a retail store.” (Specification filed April 29, 1999, page 1, lines 4-5). First, to say that an invention “relates” to something is not the same as saying the invention is limited to something, and this rationale for the rejection of claim 43 is wrong for this reason alone.

Second, the “content of applicant's specification is not used as evidence that the scope of the claims is inconsistent with the subject matter which applicants regard as their invention . . . agreement, or lack thereof, between the claims and the specification is properly considered only with respect to 35 U.S.C. 112, first paragraph; it is irrelevant to compliance with the second paragraph of that section.” Manual of Patent Examining Procedure (MPEP) 2172, II.

² The Examiner also applied this paragraph to claim 29, discussed earlier in the instant Brief.

The Examiner states:

[Claim 43 is] rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (the use of a computer system in this application). These claims would be incomplete if missing this element and they are rejected on 35 U.S.C. § 112, second paragraph. Viewing as a whole, those independent claims must include a computer system (or a computer-implemented method) for operating claimed means/steps (see at least the specification for using of a computer system in this application); without claiming this structure as essential “baseline” of this application, the claim is incomplete.

(Final Office Action page 8).³

This rationale for the rejection of claim 43 is wrong. The “content of applicant's specification is not used as evidence that the scope of the claims is inconsistent with the subject matter which applicants regard as their invention . . . agreement, or lack thereof, between the claims and the specification is properly considered only with respect to 35 U.S.C. 112, first paragraph; it is irrelevant to compliance with the second paragraph of that section.” Manual of Patent Examining Procedure (MPEP) 2172, II. “Section 112 ¶2 instructs the applicant to ‘distinctly claim[] the subject matter which the applicant regards as his invention.’ This does not automatically require inclusion in every claim of every element that is part of the device or its operation.” *Reiffin v. Microsoft Corp.* at 1347.

³ The Examiner also applied this paragraph to claim 29, discussed earlier in the instant Brief.

The Examiner also states

[T]he use of at least a computer is obviously required for this invention, without claiming it, the claim is incomplete and it can be rejected on 35 U.S.C. 112, second paragraph.

(Final Office Action page 3).

This statement by the Examiner is incoherent, since the claims themselves define the invention. Although an element of a claim may be supported by a structure in the specification, nothing in 35 U.S.C. § 112 requires that the claim be limited to that structure, or that the claim recite particular terminology.

Claims 19-24, 26 and 28 (Group A)
are Patentable under 35 U.S.C. § 112, Second Paragraph

In this Brief, claim 19 represents claims 19-24, 26, and 28 (Group A).

Each of claims 19-24, 26, and 28 employs common terminology to recite its features, and each feature is interrelated in a definite way with every other feature. Thus, each of claims 19-24, 26, and 28 points out and distinctly claims the subject matter that applicants regards as the invention.

The Examiner states:

Evidence that [claim 19 fails] to correspond in scope with that which applicant(s) regard as the invention can be found in Paper No. 1 filed 4/29/1999. In that paper, applicant has stated that the invention is about “a computer system configuration and method for processing discount information in a retail store.”, and this statement indicates that the invention is different from what is defined in the claim(s) because there is no such subject matter’s limitations in the bodies of those claims (a limitation of the claim only

counts if it is disclosed in the body of a claim) These claims would be incomplete if this baseline is left-out; therefore, they are still proper with 35 U.S.C. § 112, second paragraph, rejections.

(Final Office Action page 7) (emphasis in original).⁴

This rationale for the rejection of claim 19 is wrong because Applicants' statement on page 1 of the specification, is that the "invention relates generally to a store and, more particularly to a computer system configuration and method for processing discount information in a retail store." (Specification filed April 29, 1999, page 1, lines 4-5). First, to say that an invention "relates" to something is not the same as saying the invention is limited to something, and this rationale for the rejection of claim 19 is wrong for this reason alone.

Second, the "content of applicant's specification is not used as evidence that the scope of the claims is inconsistent with the subject matter which applicants regard as their invention . . . agreement, or lack thereof, between the claims and the specification is properly considered only with respect to 35 U.S.C. 112, first paragraph; it is irrelevant to compliance with the second paragraph of that section." Manual of Patent Examining Procedure (MPEP) 2172, II.

The Examiner states:

[Claim 19 is] rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (the use of a computer system in this application). These claims would be incomplete if missing this element and they are rejected on 35 U.S.C. § 112,

⁴ The Examiner also applied this paragraph to claim 29, discussed earlier in the instant Brief.

second paragraph. Viewing as a whole, those independent claims must include a computer system (or a computer-implemented method) for operating claimed means/steps (see at least the specification for using of a computer system in this application); without claiming this structure as essential “baseline” of this application, the claim is incomplete.

(Final Office Action page 8).⁵

This rationale for the rejection of claim 19 is wrong. The “content of applicant's specification is not used as evidence that the scope of the claims is inconsistent with the subject matter which applicants regard as their invention . . . agreement, or lack thereof, between the claims and the specification is properly considered only with respect to 35 U.S.C. 112, first paragraph; it is irrelevant to compliance with the second paragraph of that section.” Manual of Patent Examining Procedure (MPEP) 2172, II. “Section 112 ¶2 instructs the applicant to ‘distinctly claim[] the subject matter which the applicant regards as his invention.’ This does not automatically require inclusion in every claim of every element that is part of the device or its operation.” *Reiffin v. Microsoft Corp.* at 1347.

The Examiner also states

[T]he use of at least a computer is obviously required for this invention, without claiming it, the claim is incomplete and it can be rejected on 35 U.S.C. 112, second paragraph.

(Final Office Action page 3).

⁵ The Examiner also applied this paragraph to claim 29, discussed earlier in the instant Brief.

This statement by the Examiner is incoherent, since the claims themselves define the invention. Although an element of a claim may be supported by a structure in the specification, nothing in 35 U.S.C. § 112 requires that the claim be limited to that structure, or that the claim recite particular terminology.

Claims 35-40 and 42 (Group C)
are Patentable under 35 U.S.C. § 112, Second Paragraph

In this Brief, claim 35 represents claims 35-40 and 42 (Group C).

Each of claims 35-40 and 42 employs common terminology to recite its features, and each feature is interrelated in a definite way with every other feature. Thus, each of claims 35-40 and 42 points out and distinctly claims the subject matter that applicants regards as the invention.

The Examiner states:

[Claim 35 is] rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (the use of a computer system in this application). These claims would be incomplete if missing this element and they are rejected on 35 U.S.C. § 112, second paragraph. Viewing as a whole, those independent claims must include a computer system (or a computer-implemented method) for operating claimed means/steps (see at least the specification for using of a computer system in this application); without claiming this structure as essential “baseline” of this application, the claim is incomplete.

(Final Office Action page 8).⁶

This rationale for the rejection of claim 35 is wrong. The “content of applicant's specification is not used as evidence that the scope of the claims is inconsistent with the subject matter which applicants regard as their invention . . . agreement, or lack thereof, between the claims and the specification is properly considered only with respect to 35 U.S.C. 112, first paragraph; it is irrelevant to compliance with the second paragraph of that section.” Manual of Patent Examining Procedure (MPEP) 2172, II. “Section 112 ¶2 instructs the applicant to ‘distinctly claim[] the subject matter which the applicant regards as his invention.’ This does not automatically require inclusion in every claim of every element that is part of the device or its operation.” *Reiffin v. Microsoft Corp.* at 1347.

The Examiner also states

[T]he use of at least a computer is obviously required for this invention, without claiming it, the claim is incomplete and it can be rejected on 35 U.S.C. 112, second paragraph.
(Final Office Action page 3).

This statement by the Examiner is incoherent, since the claims themselves define the invention. Although an element of a claim may be supported by a structure in the specification, nothing in 35 U.S.C. § 112 requires that the claim be limited to that structure, or that the claim recite particular terminology.

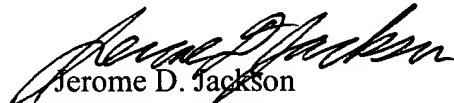
⁶ The Examiner also applied this paragraph to claim 29, discussed earlier in the instant Brief.

CONCLUSION

Thus, Appellant respectfully requests that the Board reverse the Examiner's rejection of claims 19-24, 26, 28-40, and 42-46 under 35 U.S.C. § 112, second paragraph.

If there are any other fees required for consideration of this Brief, or for any other reason, please charge such fees to the undersigned attorney's Deposit Account No. 10-0077.

Respectfully submitted,


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DATED: 1/8/02

APPENDIX - PENDING CLAIMS

19. (Amended) A system for operating with a plurality of portable cards each having a card memory, and a store having a plurality of products, the system comprising:

a plurality of cash register stations, each cash register station including

an electromagnetic detector for generating first signals corresponding to product pricing and for generating second signals identifying products selected for purchase;

a card interface for reading third signals corresponding to product pricing from the card memory of one of the portable cards;

a first processing unit that executes a first program in a first memory to correlate second signals with first signals,

wherein the system also includes a plurality of second processing units, each second processing unit executing a second program in a second memory, to correlate second signals from the electromagnetic detector, in a respective one of the cash register stations, with the third signals read by the card interface, in the respective one of the cash register stations.

20. The system of claim 19 wherein each second processing unit is in the respective one of the cash register stations.

21. The system of claim 19 further including

a central computer that communicates product pricing information with each of the first processing units.

22. The system of claim 19 further including

a network including a common computer that communicates pricing information, wherein the first processing unit, of each cash register station, is in the network, and wherein the second processing unit, of each cash register station, receives the second signals from a signal path that excludes the network.

23. The system of claim 19 further including

a switch that generates a signal indicating the end of a checkout transaction for a customer, the switch being activatable by a clerk, wherein the second processing unit is in a signal path between the switch and the first processing unit.

24. The system of claim 19 further including

a signal path from the second processing unit to the first processing unit, wherein the second processing unit sends a signal indicating a tender of a discount to the first processing unit, via the signal path.

26. The system of claim 19 further including

a switch that generates a signal indicating the end of a checkout transaction for a customer, the switch being activatable by a clerk, wherein a signal path between the switch and the first processing unit excludes the second processing unit.

28. The system of claim 19 further including a signal path from the second processing unit to the first processing unit, wherein the second processing unit sends a signal indicating a UPC coupon to the first processing unit, via the signal path.

29. (Amended) A system for operating with a plurality of portable cards each having a card memory for storing product discount information , and a store with a plurality of products, the system comprising:

a plurality of cash register stations, each cash register station including

an electromagnetic detector for generating first signals corresponding to product pricing and for generating second signals identifying products selected for purchase;

a card interface for reading from the card memory of one of the portable of cards;

a first processing unit that executes a first program in a first memory to correlate second signals with first signals,

a signal path between a peripheral device and the first processing unit,
a second processing unit, responsive to a signal on the signal path, that
executes a second program in a second memory, to correlate second signals with
third signals from the card memory of one of the plurality of card,
wherein the first processing unit determines a total amount due by receiving a
fourth signal from the second processing unit.

30. The system of claim 29 wherein the fourth signal corresponds to a discount tender.

31. The system of claim 29 wherein the peripheral device is an input device.

32. (Amended) The system of claim 29 wherein the signal path carries product
identification information.

33. The system of claim 29 wherein the peripheral device is the electromagnetic
detector.

34. The system of claim 29 further including a medium for a first computer network,
wherein a first network-interface, in each cash register station, is an interface to the first
computer network.

35. (Amended) A method for a system including a plurality of portable cards each having a card memory, and a store having a plurality of products, and a plurality of cash register stations, the method comprising:

generating first signals corresponding to product pricing and generating second signals identifying products selected for purchase;

reading third signals corresponding to product pricing from the card memory of one of the portable cards;

executing a first program in a first memory to correlate second signals with first signals, wherein the method also includes executing a second program in a second memory, to correlate second signals generated in a respective one of the cash register stations, with the third signals read in the respective one of the cash register stations.

36. The method of claim 35 wherein each step of executing a second program is performed in the respective one of the cash register stations.

37. The method of claim 35 further including
communicating product pricing information with a central computer.

38. The method of claim 35 wherein the system further includes a network with a common computer, and the method further includes that communicating pricing information with the common computer; and

receiving the second signals from a signal path that excludes the network.

39. The method of claim 35 further including
activating a manual switch to generate a signal indicating the end of a checkout
transaction for a customer; receiving the signal in the second program; and
subsequently sending the signal from the second program to the first program.

40. The method of claim 35 wherein the system further includes a signal path from the
second processing unit to the first processing unit and the method further includes
sending a signal indicating a tender of a discount to the first processing unit, via the signal path.

42. The method of claim 35 wherein the system further includes a signal path from the
second processing unit to the first processing unit and the method further includes
sending a signal indicating a UPC coupon to the first processing unit, via the signal path.

43. (Twice Amended) A method for a system including a plurality of portable cards each
having a card memory for storing product discount information, and a store with a plurality of
products, the method comprising:

generating first signals corresponding to product pricing;
generating second signals identifying products selected for purchase;
generating third signals by reading from the card memory of one of the portable of cards;

executing a first program in a first memory to correlate second signals with first signals,
sending a device signal on a signal path between a peripheral device and the first
program,

executing, responsive to the device signal, a second program in a second memory, to
correlate second signals with third signals, wherein the step of executing a first program
determines a total amount due by receiving a fourth signal from the step of executing a second
program.

44. The method of claim 43 wherein receiving the fourth signal includes receiving a
discount tender.

45. The method of claim 43 wherein sending a device signal includes sending the device
signal from the peripheral device to the first program.

46. The method of claim 43 wherein sending the device signal includes sending product
identification information.